

REMARKS

Claims 1 through 82 are currently pending in the application.

Claims 51 through 82 are withdrawn from consideration as being directed to a non-elected invention.

Claims 1 through 50 are rejected.

This amendment is in response to the Office Action of June 1, 2004.

35 U.S.C. § 101 Double Patenting Rejection

Claims 1 through 50 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 through 50 of prior U.S. Patent 6,351,028 (hereinafter referred to as the '028 patent). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicant asserts that a reliable test for statutory double patenting under 35 U.S.C. § 101 is whether a claim in the application can be literally infringed without literally infringing a corresponding claim in the patent. Is there an embodiment of the invention that falls within the scope of one claims but not the other? If there is such an embodiment of the invention, then identical subject matter is not defined by both claims and statutory double patenting under 35 U.S.C. § 101 does not exist. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicant has amended the claimed invention to clearly eliminate any statutory double patenting under 35 U.S.C. § 101 regarding the '028 patent.

Applicant asserts that no statutory double patenting under 35 U.S.C. § 101 exists between the embodiments of the presently claimed inventions of presently amended independent claims 1, 17, and 40 of the present application and the embodiments of the inventions set forth in corresponding claims 1, 17, and 40 of the '028 patent because different embodiments of the inventions are being claimed. For instance, the embodiments of the inventions set forth in presently amended independent claims 1, 17, and 40 of the present application set forth elements of the inventions calling for "An interposer apparatus for use between a first semiconductor device and a second semiconductor device . . . comprising . . . a first surface having a first length, a first width, and a coefficient of thermal expansion and a second surface having a length, a width smaller than said first width of said first surface, and a coefficient of thermal expansion substantially the same as the coefficient of thermal expansion of the first

surface" and "An interposer apparatus for use between a plurality of semiconductor devices . . . comprising . . . a first surface having a first length, a first width, and a coefficient of thermal expansion . . . a second surface having a length, a width smaller than said first width of said first surface, and a coefficient of thermal expansion substantially the same as the coefficient of thermal expansion of the first surface . . . " whereas the embodiments of the inventions of the '028 patent set forth in corresponding independent claims 1, 17, and 40 do not. Therefore, no statutory double patenting exists between the embodiments of the inventions set forth in presently amended independent claims 1, 17, and 40 of the present application and the embodiments of the inventions set forth in corresponding independent claims 1, 17, and 40 of the '028 patent. Accordingly, claims 1, through 50 of the present application are allowable.

For the reasons set forth herein, Applicant requests the allowance of claims 1 through 50 and the case passed for issue.

Respectfully submitted,



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Date: September 1, 2004

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